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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,334	03/14/2001	Stephen J. Brown	HERO-1-1111 / 014030.0146	6688
60683 7590 02/05/2007 HEALTH HERO NETWORK, INC. 2000 SEAPORT BLVD. SUITE 400 REDWOOD CITY, CA 94063			EXAMINER KOPPIKAR, VIVEK D	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/810,334

Applicant(s)

BROWN, STEPHEN J.

Examiner

Vivek D. Koppikar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Application***

1. Claims 1-19 have been examined in this application. This is a First Office Action in response to the Request For Continued Examination (RCE) filed on December 5, 2006. In an telephonic interview with Christopher P. Maiorana, the attorney of record, on January 26, 2007, the attorney indicated that this instant application is not a child application of any other pending patent application.

### ***Claim Objections***

2. Claims 1 is objected to because of the following informalities: The applicants use the terms "first number" and "second number" on lines 13 and 18, respectively, in claim 1. It is not clear whether "first number" and "second number" refer to the same quantity. Appropriate clarification and/or correction is required. For the purposes of examination, "first number" and "second number" will be interpreted as referring to separate quantities.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,897,493 to Brown in view of US Patent Number 5,765,139 to Bondy in further view of US Patent Number 6,584,445 to Papageorge.

(A) As per claim 1, Brown teaches

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a server comprising (Brown: Col. 4, Ln. 43-51);

a questionnaire generator for (i) generating a questionnaire comprising (a) one or more questions for determining at least one of a physical condition of said individual, a mental condition of said individual, and a behavior of said individual, and for transmitting said questionnaire from said server to said remotely programmable apparatus, wherein the apparatus is (a) associated with an individual and (b) remotely located from the server (Figures 2 and 5 ((94) and 98)) and Col. 5, Ln. 7-19);

Brown does not teach an expression of risk for an individual and (b) a first number of answer options to each of said questions, wherein the expression of risk concerns a condition and (ii) associating each of the answer options with one of a second member of values representing a level of risk and Brown does not teach a profile generated for (i) generating a profile for said individual based on one or more aspects of care, the expression of risk and the level of risk and assigning a subsequent program to the individual based on the profile, however, this feature is taught by Papageorge (Col. 8, Ln. 44-47, Ln. 58-63 and Ln. 65-67 and Col. 9, Ln. 6-17).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Brown with the aforementioned teachings from Papageorge with the motivation of having a means of helping patients make informed decisions, as recited in Papageorge (Col. 1, Ln. 14-24).

and wherein said remotely programmable apparatus (Brown: Col. 4, Ln. 55-60) comprises:

a communication means for receiving said questionnaire and said script program from said server and for transmitting said responses to said server (Brown: Col. 4, Ln. 47-51);

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a user interface for communicating said questionnaire and said script program to said individual and for receiving said responses (Brown: Col. 4, Ln. 49-51);

a memory for storing said questionnaire, said script program, and said responses (Brown: Col. 7, Ln. 1-9); and

a processor connected to said communication means, said user interface and said memory for executing said questionnaire and said script program to communicate said questions to said individual, to receive said responses to said questions, and to transmit said responses to said server (Brown: Col. 7, Ln. 11-17).

Brown does not teach the following (structural) feature which is taught by Bondy (Figure 2 (Arrows 210, 212, 214) and Col. 3, Ln. 30-35):

a three dimensional data structure.

At the time of the invention, one of ordinary skill in the art would have been motivated to modify the teachings of Brown with the aforementioned teachings from Bondy with the motivation of having a means of automatically transforming data from one type of data structure into another type of data structure, as recited in Bondy (Col. 2, Ln. 15-20).

The combined teachings of Brown in view of Bondy do not teach that the first dimension represents an aspect of care, a second dimension represents an expression of risk and a third dimension represents a level of risk, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the

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prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Brown in view of Bondy so that the three dimensional data structure contained the three above mentioned types of data with the motivation of having a means of better being able to provide a patient with an assessment of risk relating to their aspect of care.

(B) As per claim 2, in Brown the profile of said individual is updated based on follow-up responses (Brown: Col. 5, Ln. 63-Col. 6, Ln. 4).

(C) As per claim 3, in Brown the profile further comprises, a language of said individual, and a current health condition of said individual; and said script generator also tailors questionnaire and said script program in dependence upon said language and said current health condition of said individual (Brown: Col. 4, Ln. 59-60).

(D) As per claim 4, in Brown the questionnaire generator further generates a motivational profile and comprehension capacity profile of said individual based on one or more answers (Brown: Col. 8, Ln. 65-Col. 9, Ln. 8) and Papageorge (Col. 8, Ln. 58-61). The motivation of making this modification to the teachings of Brown is set forth above in the rejection of claim 1.

(E) As per claim 5, in Brown the subsequent program comprises: a request for additional responses (Col. 2, Ln. 18-25);

and educational information (Brown: Col. 5, Ln. 9-15 and Ln. 33-42).

(F) As per claim 6, in Brown the educational information is received by a server from an external source (Brown: Col. 10, Ln. 8-15).

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(G) As per claim 7, in Brown the data relating to said physical condition of said individual comprises one or more measurements received by a server from a monitoring device connected to said apparatus (Brown: Col. 4, Ln. 61-Col. 5, Ln. 6).

(I) As per claim 9, in Brown the data related to said physical condition of said individual comprises electronic medical records received by said server from a services organization associated with said individual (Brown: Col. 8, Ln. 5-24).

(J) As per claims 10-16 and 18, this claim is substantially similar to claim 1-9, above, respectively, and is therefore rejected on the same basis as claim 1, as set forth above.

external source of additional educational information and means for transferring said additional educational information from said external source to said remotely programmable apparatus (Brown: Col. 10, Ln. 8-15).

(S) As per claim 19, in Brown teaches a storage medium for use in a server to communicate with one or more patient devices, the storage medium recording a computer program that is readable and executable by the server (Brown: Abstract), the computer program comprising the steps of:

(A) displaying a plurality of icons of a plurality of questions, a plurality of answers and a plurality of follow-up actions (Brown: Figure 5 and Col. 5, Ln. 52-62);

(B) receiving a selection to each of a particular question of said questions, a particular answer of said answers and a particular follow-up of said follow-up actions from a user (Brown: Figure 5 and Col. 5, Ln. 52-63);

(C) linking the icons of a particular question and the particular answer and the particular follow-up action (Brown: Figure 5, Col. 5, Ln. 52-62).

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(D) converting the linked icons into a subsequent program; and

(E) transmitting the subsequent program to said one or more patient devices over a communication network (Brown: Figure 5, Col. 5, Ln. 52-62).

Brown does not teach an expression of risk for an individual and (b) a first number of answer options to each of said questions, wherein the expression of risk concerns a condition and (ii) associating each of the answer options with one of a second member of values representing a level of risk and Brown does not teach a profile generated for (i) generating a profile for said individual based on one or more aspects of care, the expression of risk and the level of risk and assigning a subsequent program to the individual based on the profile, however, this feature is taught by Papageorge (Col. 8, Ln. 44-47, Ln. 58-63 and Ln. 65-67 and Col. 9, Ln. 6-17).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Brown with the aforementioned teachings from Papageorge with the motivation of having a means of helping patients make informed decisions, as recited in Papageorge (Col. 1, Ln. 14-24).

Brown does not teach the following (structural) feature which is taught by Bondy (Figure 2 (Arrows 210, 212, 214) and Col. 3, Ln. 30-35):

a three dimensional data structure.

At the time of the invention, one of ordinary skill in the art would have been motivated to modify the teachings of Brown with the aforementioned teachings from Bondy with the motivation of having a means of automatically transforming data from one type of data structure into another type of data structure, as recited in Bondy (Col. 2, Ln. 15-20).



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The combined teachings of Brown in view of Bondy do not teach that the first dimension represents an aspect of care, a second dimension represents an expression of risk and a third dimension represents a level of risk, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Brown in view of Bondy so that the three dimensional data structure contained the three above mentioned types of data with the motivation of having a means of better being able to provide a patient with an assessment of risk relating to their aspect of care.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Papageorge and in further Bondy, as applied to Claims 1 and 10, above, respectively, in

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even further view of US Patent Application Publication 2002/0010597 to Mayer and in even further view of Official Notice.

(A) As per claims 8 and 17, Brown does not teach that the data related to the physical condition of the individual comprises electronic medical claims received by said server from a medical claims paying organization associated with said individual (Figure 5 and Section [0046]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system and method of Brown by adding the aforementioned feature from Mayer with the motivation of providing an enhanced computerized tool for maintaining and managing various aspects of patients' healthcare, as recited in Mayer (Section [0003]). Mayer does not explicitly recite medical claims, however, the Examiner takes Official Notice that it is well-known in the health care industry that medical claims comprise data relating to the physical condition of an individual (patient) (e.g. in the form of ICD and/or CPT codes) and at the time of the invention, one of ordinary skill in the art would have been motivated to have modified the teachings of Brown, Papageorge, Bondy and Mayer with this aforementioned teachings with the motivation of having a means of having a means of referencing the particular service a health care services organization is paying for when it is reimbursing a patient for a medical claim that has been made on behalf of the patient by a health care provider.

#### ***Response to Arguments***

6. Applicant's arguments filed on December 5, 2006 with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

***Examiner's Suggestions***

7. The examiner recommends amending the claims to recite a specific formula or function of the "expression of risk" which is mentioned in the independent claims. The examiner would like to note however that any amendment should have support in the specification and, in addition, any amendment will be subject to an updated prior art search.

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*Conclusion*

8. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,  
*V/K*  
Vivek Koppikar

*Carolyn Bleck*  
*PATENT EXAMINER 3626*  
*2/2/07*

1/26/2007